<center>**REMARKS**</center>

Claims 108-117, 124-125, 151-155, 157, and 176-183 were pending and presented for examination and in this application. In an Office Action dated February 2, 2009, claims 108-117, 124-125, 151-155, 157, and 176-183 were rejected. Claims 117, 155, and 183 are cancelled without prejudice or disclaimer.

Response to Rejection for Enablement Under 35 USC §112, Paragraph 1

In the Office Action, claims 108, 151, and 176 were rejected under 35 USC §112, ¶1 as allegedly failing to comply with the enablement requirement. This rejection is respectfully traversed.

For this rejection, the Office Action points to Specification, p. 7, ll. 15-22, and concludes: "This disclosure clearly indicates that *the user is in communication with the server* and that the log is not to gain access to the server, but to information that is present on the server." Office Action, p. 3. Applicants disagree with this characterization.

As both the specification and claim indicate, the server system is in communication with **a client system**. In response to the single action being performed, the request to order is sent along with **the client identifier**, which identifies **the client system** to the server system. Thus, **the client system**, *rather than the user as contended in the Office Action*, is in communication with **the server system**. In fact, the previous step of the claim indicates that the request is sent "*without* requiring a user to log in to the server system," i.e., server system communication with **the client system** suffices, without specific user identification. However, to change account

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information, **the user** himself needs to log in to the server system, i.e., communication with just the client system is not enough. Applicants have amended claims 108 and 176 to provide further clarification of this aspect of the claimed invention. Claim 151 did not require such clarification.

Therefore, Applicants maintain that claims 108, 151, and 176 comply with the enablement requirement.

In the Office Action, claims 117, 155, and 183 also were rejected under 35 USC §112, ¶1 as allegedly failing to comply with the enablement requirement. Claims 117, 155, and 183 have been cancelled, rendering this rejection moot.

Response to Rejection under 35 USC §112, Paragraph 4

In the Office Action, claims 117, 155, and 183 were rejected under 35 USC §112, ¶4 as allegedly failing to comply with further limiting the subject matter of the previous claim(s). Claims 117, 155, and 183 have been cancelled, rendering this rejection moot.

Response to Rejection Under 35 USC §103(a)

In the Office Action, claims 108-113, 117, 124-125, 151-155, 157, 176-180, and 183 have been rejected under 35 USC §103(a) as allegedly being anticipated over U.S. Patent 5,963,915 ("Kirsch") in view of "The End of Money?," by Levy ("Levy"). This rejection is respectfully traversed.

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Applicants note that Levy was previously cited by Applicants in the IDS filed 2/13/2006.

Claim 108 now recites:

A computer-implemented method in a client system for ordering an item, the method comprising:

receiving from a server system a client identifier of the client system;

persistently storing the client identifier at the client system;

for an item to be ordered:

providing for display information identifying the item and an indication of a single action that is to be performed to order the identified item; and

in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier without requiring a user to log in to the server system, the request to order being an order indicated by the single action and the client identifier identifying account information previously supplied by the user of the client system; and

responsive to a request to change account information:

receiving log in credentials of the user;

receiving updated account information; and

sending the updated account information to the server system.

Several aspects of the claimed invention are not disclosed or suggested by the cited references considered alone or in the combination proposed by the Examiner.

First, Kirsch does not disclose or suggest "for an item to be ordered: **providing for display…an indication of a single action that is to be performed to order the identified item**."

For this aspect of the claimed invention, the Office Action points to Kirsch 8:64-9:4. This section does not provide any recitation of any aspect of Kirsch that would serve as the claimed indication. At best, FIG. 2 of Kirsch provides hyperlinks 26-32 that can correspond to products or services, and allow for additional information,

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availability information, ordering, etc. *See e.g.,* Kirsch, 7:27-42. However, Kirsch does not disclose or suggest also displaying an indication of any "single action to be performed to order the identified item." For the reasons described below with respect to the "two phase operation" of Kirsch, Kirsch *would not* provide such an indication since an additional confirmation step is required.

Second, Kirsch does not disclose or suggest "in response to the **single action** being performed, sending to the server system a request to order the identified item … the request to order being **an order indicated by the single action**…."

Kirsch teaches an ordering method that *requires* two explicit steps. Kirsch teaches "providing for a purchase transaction that appears to the client user as a singular selection of a purchasable product or service **and** a singular confirmation of the purchase." Kirsch, col. 4, ll. 48-51 (emphasis added). Despite this requirement, the Office Action argues that "Kirsch implicitly contemplates an order being purchased with just one of the phases," and cites Kirsch 11:12-15. Office Action, p. 6. Applicants first note that Kirsch appears to be misquoted. Applicants cannot locate the quoted "no more than two mouse clicks" language in the section provided. Rather, the sentence in the cited section reads "the entire purchase transaction from the client user perspective **remains a simple two phase operation** requiring at most only two mouse clicks for complete execution of the purchase." Kirsch, 11:12-15 (emphasis added); *see also* 8:66-9:1. It is unclear to Applicants, in light of the quoted section, how Kirsch could be interpreted to require only one phase as the Office Action argues.

Applicants note language similar to that quote provided appears in Kirsch at 15:17-18: "allowing a product or service to be purchased with no more than two

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required mouse clicks…" (emphasis added). It appears from this context that this section means *nothing* more than the two **required** mouse clicks are needed for the purchase. Applicants submit that it is inconsistent with the context of these portions of Kirsch, and with Kirsch's overall disclosure, to conclude from this language that "less than two clicks is anticipated," as stated in the Office Action, p. 6.

Third and finally, Kirsch also does not disclose or suggest "responsive to a request to change account information: receiving log in credentials of the user." Applicants note that this argument was presented in the Amendment filed December 29, 2008. However, it was not addressed in the Response to Arguments section of the pending Office Action; the rejection is merely repeated nearly verbatim from the prior action.

Kirsch merely discloses an additional verification step after a purchase acceptance has been given by the client user. This verification step utilizes a PIN maintained by the server to be matched against the client record in order to provide a greater degree of authentication. *See* Kirsch, col. 14, ll. 44-53. However, this is not "receiving log in credentials of the user" because Kirsch discloses a PIN that is separate from the login and password used to log into the server system. *See* Kirsch, col. 6, ll. 30-34. Applicants note that this separate PIN verification is optional and used if a specific server requires a PIN for all purchases, and that an order is not processed without a valid PIN. *See* Kirsch, col. 14, ll. 47-53. Thus, Kirsch does not disclose "responsive to a request to change account information: receiving log in credentials of the user." Applicants have addressed the section 112 issue with respect to this language, above.

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Thus, for the several reasons above, Kirsch does not disclose these claimed elements.

Levy does not remedy the deficiencies of Kirsch, nor does the Office Action argue that it does, for all but the single action arguments above. Thus, the deficient disclosures of these references, considered either alone or in the combination suggested by the Examiner, fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. §103(a) can be made, since the references do not teach or suggest all of the claimed limitations. Accordingly, Applicants submit that claim 1 is patentably distinguishable over the cited references.

With respect to the single action aspect discussed above, the Office Action also relies on Levy. The Office Action admits that Kirsch "does not explicitly teach that there is one step ordering and a confirmation page is not sent to the buyer." Office Action, p. 6. Applicants interpret this statement as an admission that Kirsch does not explicitly teach that an order is "in response to **the single action** being performed" and "**an order indicated by the single action**."

The Office Action quotes the first paragraph of Levy, and concludes that Levy discloses an order that "consummates…without a confirmation page." Office Action, p. 6. Applicants disagree with this reading of Levy.

Levy is an article in Newsweek magazine that refers to a system of electronic payment ("e-money" or "e-cash") developed by a company called DigiCash. However, Levy does not provide much technical detail as to how the system works, and thus the quoted portion of Levy has been read out of context. Applicants now refer to an additional reference for clarification of the e-cash concept and how it actually works:

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"Becoming a DigiCash Merchant," Appendix D in Magedlena Yesil, Creating the Virtual Store, p. 289-301 ("Yesil"). This reference was previously cited by Applicants in the IDS filed 2/13/2006.

E-cash is withdrawn from a bank and stored on a customer's local computer hard drive. *See* Yesil, p. 290. "While E-cash is running, a small window is displayed that shows [] the amount of E-cash available to spend." *Id.* This portion explains that the "ledger" in the corner of the screen mentioned in Levy is an amount available to spend, which amount is stored on a local computer hard drive.

At the time of a purchase, the user clicks yes to accept a merchant's payment request (p. 291, FIG. D.3), and her system transmits "digital coins" (p. 295) from the customer's hard drive to the merchant, who sends them to a bank for acceptance. *See* Yesil, p. 296, FIG. D.11. This portion explains how a purchase is made, and what occurs as a result of the customer clicking yes, namely, exchange of digital coins. The digital coins rely on a system of public-key encryption. *See* Yesil, p. 289, 298.

Thus, as Yesil explains, the system of Levy does not disclose or suggest "in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier ..., the request to order being an order indicated by the single action and the client identifier identifying account information previously supplied by the user of the client system." Rather, Levy shows verification of a payment request (FIG. D.3) for an item **after a request to buy something** (p. 291 "Bob may send a payment request to Alice, who has asked to buy something"), which results in **transfer of digital coins to the merchant**. Thus, Levy also does not show that an order is "in response to the single action being performed"

and that the order is "an order indicated by the single action." Further, when the customer clicks "yes" on the payment request, it does not trigger transmitting a "request to order" and a "client identifier" to a server system. Thus, as clarified by Yesil, the system of Levy does not remedy the deficiencies of Kirsch, and claim 1 is patentably distinguishable over Kirsch and Levy, alone or in combination, for this additional reason.

Applicants further disagree with the statement in the Office Action that "all of the elements of the cited references perform the same function when combined as they do in the prior art." Office Action, p. 7. For example, even assuming *arguendo* that Levy showed an order indicated by a single action, it would need to be modified to operate in a system such as Kirsch to send a request to order and a client identifier instead of digital coins. Similarly, to modify Kirsch to order as a result of a single action, if Levy is assumed *arguendo* to show such ordering, would require that Kirsch's "simple two phase operation" and "two **required** mouse clicks" be instead a single action.

The suggested combination thus would take the cited aspects of the references well beyond their "established functions," precluding the "predictability" of such combining under *KSR*. Thus, even assuming *arguendo* that the references stood for what the Office Action alleges, the discussion above indicates that the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." *See KSR*, 550 U.S. 398 (2007).

Claims 151 and 176 also are patentably distinguishable over Kirsch and Levy, alone or in the suggested combination, for the above reasons.

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Claims 109-116, 124-125, 152-154, 157, and 177-182, variously depend from claims 108, 151, and 176, which were shown above to be patentable over the cited references and which recite additional features not shown in the cited references. For these reasons, Applicants submit that claims 109-116, 124-125, 152-154, 157, and 177-182 also are patentably distinguishable over the cited references.

Claims 117, 155, and 183 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Kirsch in view of Levy, and further in view of Admitted Prior Art (APA) and of U.S. Patent No. 6,125,352 ("Franklin").

Claims 117, 155, and 183 have been cancelled, rendering this rejection moot.

Claims 114-116 and 181-182 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Kirsch in view of Levy and further in view of Official Notice.

As indicated above, claim 114-116 and 181-182 are patentable over the cited references. The alleged Official Notice does not remedy the above-stated deficiencies of Kirsch and Levy, nor does the Office Action allege that it does.

In the previous Amendment filed 12/29/2008, Applicants requested documentary support for the assertion that "displaying partial information to protect the user's personal information was old and well known in the art at the time of the invention." Specifically, claims 114-116 and 181-182 recite **display of** partial information about the **identity of the user of the client system**, **partial shipping information**, and **partial payment information**. In response, the Office Action provides Miller, a 1997 article about credit reporting agency Experian sending credit

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reports to the wrong people. From the article: the "report includes partial credit card numbers and other personal information designed to allow customers to identify their own reports. That would make it difficult for others to use the information illegally."

Applicants challenge this reference as supportive of the Official Notice taken. Specifically, the reference at best provides personal information for credit reporting. However, each of the claimed aspects relate to **display of** partial information in conjunction with an order for an item. Specifically, display of partial information about **the identity of the user of the client system** must not just identify a person, but **the user of the claimed system**; **partial shipping information** for the item ordered as claimed; and **partial payment information** for the **item ordered** as claimed. The Miller references provides none of these. And contrary to the assertion in the Office Action that this partial information "is not functionally related to the substrate of the invention" (Office Action, p. 15), Applicants disagree, since each is clearly tied to the claimed system and/or order.

Applicants submit that if the noticed facts were in fact "capable of instant and unquestionable demonstration as being well known" as required by MPEP 2144.03, a more relevant and on-point reference should be easily obtainable. Applicants request that such a reference be provided if this Official Notice continues to be maintained. Applicants do not admit any of the officially noticed facts and reserve the right to argue further against these assertions at a later time, if necessary.

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Conclusion

In sum, claims 108-116, 124-125, 151-154, 157, and 176-182, are patentably distinguishable over the cited references. Therefore, reconsideration of the basis for the rejections to these claims and allowance of them is now requested.

Respectfully Submitted,

Date: June 2, 2009   By: /Jennifer R. Bush/
                                Attorneys for Assignee
                                Jennifer R. Bush, Reg. No. 50,784
                                FENWICK & WEST LLP
                                801 California Street
                                Mountain View, CA 94041
                                Phone: (650) 335-7213
                                Fax: (650) 938-5200

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